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Attorney Docket No. I4060/257219

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TC 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jeffrey D. Irwin, et al.

Serial No.: 09/800,368

Art Unit: 1751

Filed: March 6, 2001

Examiner: Elisa B. Elhilo

For: MOISTURE BARRIER FABRIC AND METHODS OF MAKING SAME

Assistant Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Dear Sir:

This paper is submitted in response to the Office Action mailed May 6, 2003 in connection with the above-identified application.

In a September 24, 2002 Office Action, the Examiner restricted the prosecution of the application to one of the following four groups:

- | | |
|-----------|--|
| Group I | Claims 1-5 and 36, drawn to a method of needling fabric; |
| Group II | Claims 6-13, drawn to a method of washing fabric; |
| Group III | Claims 14-21, drawn to a method of coating fabric; or |
| Group IV | Claims 22-35, drawn to a method for treating fabric with a solution. |

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this RESPONSE TO OFFICE ACTION, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on this 14th day of May, 2003 with sufficient postage as first-class mail in an envelope addressed to the Assistant Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

Justin D. Haugen
Signature

Applicants elected with traverse the invention of Group I as represented by claims 1-5 and 36. The May 6, 2003 Office Action has now removed claim 36 from Group I and maintains that claim 36 is a linking claim and will be examined with the Group elected by applicants.

Applicants hereby elect with traverse the invention of Group I as represented by claims 1-5 and assume that claim 36 will therefore be examined with the claims of elected Group I. Applicants also understand that if claim 36 is allowed, then the restriction requirement should be withdrawn. MPEP 809.

The Examiner maintains that Groups I-IV are unrelated. According to the Action, "inventions are unrelated if it can be shown that [(1)] they are not disclosed as capable of use together and [(2)] they have different modes of operation, different functions, or different effects." Action, ¶ 2. However, the Action fails to demonstrate and cannot demonstrate that the inventions of Groups I-IV are not disclosed as capable of use together. The Application clearly discloses that the methods recited in the claims of Groups I-IV may be used together. *See, e.g.*, Application, page 4, lines 1-12. In fact, claim 36 explicitly recites the use of the methods together. Thus, the Action has failed to demonstrate that the inventions are independent and the restriction requirement is improper.

Claim 36 is a combination claim and claims 1, 6, 14, and 22 are subcombination claims. The Action has failed to establish that restriction between any of Groups I-IV and claim 36 is proper. In fact, such a showing is impossible at least because the Examiner cannot establish two-way distinctness. Rather, combination claim 36 requires the particulars of subcombination claims 1, 6, 14, and 22, and thus these claims must be examined together in the same application. MPEP 806.05.

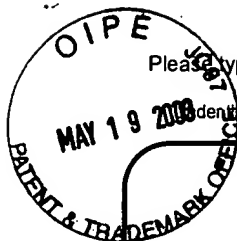
Moreover, examination of elected Group I will necessarily require the same field of search necessary for examination of Groups II-IV since the methods recited in these groups form elements of claim 36. As a result, in order to properly search and examine claim 36, the Examiner must search in the art for the methods recited in claims 6, 14, and 22 of non-elected Groups II-IV, respectively. The presence of all of the inventions in a single application therefore imposes no undue burden on the Examiner. Because Applicants have shown that restriction of any of the inventions is improper, withdrawal of the requirement and examination of all of the claims on the merits is respectfully requested.

Respectfully submitted,



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PTO/SB/21 (08-00)

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

4

Application Number

09/800,368

Filing Date

March 6, 2001

First Named Inventor

Jeffrey D. Irwin, et al.

Group Art Unit

1751

Examiner Name

Elisa B. Elhilo

Attorney Docket Number

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ENCLOSURES (check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

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☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/
Incomplete Application

☐ Response to Missing
Parts under 37 CFR
1.52 or 1.53

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(for an Application)

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☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a
Provisional Application

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☐ After Allowance Communication to
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Kristin L. Johnson, Reg. No. 44,807

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Susie D. Haugen

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May 14, 2003

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